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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,459	05/15/2001	Daisuke Iseki	520.40129X00	8074

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EXAMINER

LEE, PHILIP C

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,459

Applicant(s)

ISEKI ET AL.

Examiner

Philip C Lee

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-15 are presented for examination.
2. The specification is objected to because of the following informalities and grammar errors, page 1, line 5, "photograph1c" and page 23, line 17, "the use button 303 and store button 304" [i.e. store button 303 and use button 304]. Appropriate correction is required.
3. The information disclosure statement filed 5/15/2001 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections – 35 USC 112

4. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. The following terms lack proper antecedent basis:
 - i. the open YES/NO information – claim 1.
 - ii. the open YES information – claims 1 and 6.
 - iii. the digital open album information – claim 1.

- iv. the retrieval request – claim 1.
- v. said registered image information – claim 2.
- vi. the electronic private service site – claim 2.
- vii. said image – claim 2.
- viii. the points of the image provider – claims 3 and 5.
- ix. the open image – claim 3.
- x. the application conditions of the open image – claims 3 and 4.
- xi. said open service site – claims 3 and 4.
- xii. the image provider – claims 4 and 5.
- xiii. said information – claim 6.
- xiv. the confirmation information – claim 6.

b. Claim language in the following claims is not clearly understood:

- i. As per claim 1, lines 7-8, it is unclear what information is being retrieved [i.e. image information or application of transaction or open YES/NO information?]; Lines 9-11, it is unclear how the image information gives the open YES information as the digital open album information to open this digital open album information [i.e. by selecting a YES or NO option?]; Lines 14-15, it is uncertain if “said digital open album information” refers to “the open YES information” in lines 9-10.
- ii. As per claim 2, line 1, it is unclear if “The digital album site running system” refers to “An electronic service site running system” in claim 1, line 1

[i.e. Since claim 2 depends upon claim 1, the preamble of claim 2 must be corrected to "The electronic service site running system"]; Lines 2-3, it is not clearly understood if "said registered image information" refers to "image information" in claim 1, line 3, if so, it is unclear if the image information will be stored as digital open YES information in claim 1, line 9 or stored as digital private album information as in claim 2, lines 2-3.

iii. As per claims 3-7, line 1, they have the same uncertainty as in claim 2, line 1 above.

iv. As per claim 3, line 3, it is not clearly understood if the "image provider" refers to the "image provider terminal" in claim 1, lines 7-8; Lines 5-6, it is uncertain what is "the application conditions of the open image"; Line 4, it is unclear if "the open image" refers to "image information" in claim 1, line 3; Line 6, it is unclear if "said open service site" refers to "the electronic service site" in claim 1, line 11; Line 3-6, it is not clearly understood if the points of the image provide having offer the open image being change refers to the points of the image provider in claim 3, line 3 [i.e. are they the same or different set of points?].

v. As per claim 4, it has the same uncertainties as in claim 3 above.

vi. As per claim 5, lines 6-7, it is unclear what is the relationship between points and said digital private album.

vii. As per claim 6, line 5, it is uncertain if "said information" refers to "open YES/NO information", "position information", or "date information".

- viii. As per claims 8, 10 and 14, they have the same uncertainties or problems as in claim 1 above.

Claim Rejections – 35 USC 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-2, 8-9, 10, 12 and 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe et al, U.S. Patent 6,578,072 (hereinafter Watanabe).

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8. As per claims 1, 8, 10 and 14 (as interpreted), Watanabe taught the invention as claimed for opening the electronic service sites by preparing a mechanism to realize storing of image information and application of transaction and for connecting a plurality of terminals to the electronic service site via the communication line (fig. 1; col. 5, lines 38-58; col. 6, lines 9-22; col. 8, lines 50-53, lines 58-61); said running system accepts the image information including the open YES/NO information and retrieval information from an image provider terminal (figs. 3 and 7; col. 7, lines 20-25; col. 9, lines 20-42);

stores the image information given the open YES information as the digital open album information to open this digital open album information in the electronic service site (figs. 3 and 7; col. 7, lines 20-25; col. 9, lines 20-42); and

accepts the retrieval request to said electronic service site from an image user terminal and retrieves the image information matched with said retrieval request from said digital open album information based on said retrieval request to provide the retrieval result to said image user terminal (col. 6, lines 33-56).

9. As per claims 2, 9 and 15 (as interpreted), Watanabe taught the invention as claimed in claims 1, 8 and 14 above. Watanabe further taught that said running system stores said registered image information as the digital private album information and retrieves, edits and outputs this digital private album information via the electronic private service site (col. 6, lines 27-28); accepts the retrieval request for said electronic private service site from said image provider terminal having requested registration of said image; retrieves the image information

matched with said retrieval request from said digital private album information based on said retrieval request; and provides the retrieval result to said image provider terminal having requested storage of said image (col. 9, lines 20-54).

10. As per claim 12 (as interpreted), Watanabe taught the invention as claimed in claim 10 above. Watanabe further taught comprising a step to change said digital album image information open YES/NO information from the image provider terminal (col. 7, lines 20-25).

Claim Rejections – 35 USC 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Shimada et al, U.S. Patent 6,012,635 (hereinafter Shimada).

13. As per claim 3 (as interpreted), Watanabe taught the invention as claimed in claim 1 above. Watanabe did not teach recording points according to the condition of services. Shimada taught that said running system is provided with a database for recording the points of the image provider and the points of the database of image provider having offered the open image are changed based on the application conditions of the open image retrieved in said open service site (col. 2, lines 66-col. 3, lines 15).

14. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Watanabe and Shimada because Shimada's system of recording points according to the condition of services would increase the efficiency of Watanabe's system by tracking the utilization of services for billing using a points system.

15. Claims 4, 6-7, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Thompson, U.S. Patent 6,650,831 (hereinafter Thompson).

16. As per claims 4 and 11 (as interpreted), Watanabe taught the invention as claimed in claims 2 and 10 above. Watanabe did not teach expense could be alleviated based on the application conditions. Thompson taught a similar system wherein the storage expense for said digital private album information stored with the image provider having offered the open image is alleviated based on the application condition of the open image retrieved with said open service site (col. 4, lines 11-20).

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17. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Watanabe and Thompson because Thompson's method of alleviating expenses would increase the fairness of Watanabe's system by adjusting the charges to a user based on the services provided.

18. As per claims 6 and 13 (as interpreted), Watanabe taught the invention as claimed in claims 1 and 10 above. Watanabe did not teach accepting and storing position and date information. Thompson taught a system wherein said running system accepts the image information including open YES/NO information, position information and date information from the image provider terminal and temporarily stores said information and determines the open YES/NO information of said image information temporarily stored based on the confirmation information from said image provider terminal in order to store the image information given the open YES information as the digital open album information (col. 2, lines 34-40; col. 2, lines 66-col. 3, lines 9; col. 7, lines 43-49).

19. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Watanabe and Thompson because Thompson's method of storing additional information would increase the field of use in their system.

20. As per claim 7 (as interpreted), Watanabe taught the invention as claimed in claim 1 above. Watanabe did not teach providing advertisement information. Thompson taught a system wherein the image information provided to the image user terminal together with said

retrieval result is provided together with the advertisement information (col. 3, lines 19-22; col. 7, lines 49-53; col. 9, lines 55-59).

21. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Watanabe and Thompson because Thompson's method providing advertisement information would enhance Watanabe's system by allowing image hosting provider to target viewers with marketing information (col. 7, lines 49-53).

22. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, Thompson and Shimada in view of Isono et al, U.S. Patent 5,689,299 (hereinafter Isono).

23. As per claim 5 (as interpreted), Watanabe and Thompson taught the invention substantially as claimed in claim 4 above. Watanabe and Thompson did not teach recording points according to the condition of services. Shimada taught that said running system is provided with a database for recording the points of the image provider and the points of the database of image provider having offered the open image are changed based on the application conditions of the open image retrieved in said open service site (col. 2, lines 66-col. 3, lines 15).

24. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Watanabe, Thompson and Shimada because Shimada's system of recording points according to the condition of services would increase the

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efficiency of Watanabe's and Thompson's systems by tracking the utilization of services for billing using a points system.

25. Watanabe, Thompson and Shimada did not teach expense could be alleviated based on the request from said image provider terminal. Isono taught that the storage expense of said digital private album information of which points are stored with the image provider is alleviated based on the request from said image provider terminal (col. 15, lines 51-55).

26. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Watanabe, Thompson, Shimada and Isono because Isono's method of alleviating expenses would increase the fairness of Watanabe's, Thompson's and Shimada's systems by adjusting the charges to a user based on the services provided.

CONCLUSION

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Garfinkle et al, U.S. Patent 6,133,985, disclosed a system for processing digital images and distributing visual prints.

Shiimori, U.S. Patent 6,567,983, disclosed a system for storing and viewing of electronic album.

28. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (703)305-7721. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday.

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703)305-8498. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

31. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)350-6121.

P.L.

Wen-Jen F
8/31/04